

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claim amendments

Claims 1-3, 7-11, and 17-19 are amended to remove reference numerals. It is respectfully submitted that no new matter is added, since the use of reference numerals does not affect the scope of the claims (MPEP § 608.01(m)).

Claims 1, 3, and 17 are further amended in order to clarify that there is no invocation of 35 U.S.C. § 112, 6<sup>th</sup> paragraph. Specifically, in the case of amendments effectively changing an original claim element expressed as a “means plus function” that could raise a presumption of claim expression under 35 U.S.C. 112, 6<sup>th</sup> paragraph to a structural expression or to an expression removing the presumption of a “means-plus-function” statement, it is not intended to narrow the claim so amended for purposes of patentability, but rather to place the claim in a form considered to be intended by the applicant from a foreign country where claim limitations described in terms of means-plus-function do not have the same effect as under U.S. practice. Thus, such amendments are intended to establish a full range of equivalents to the claim elements so amended under the U.S. doctrine of equivalents and beyond the range associated with “means-plus-function” expressions according to 35 U.S.C. 112, 6<sup>th</sup> paragraph, just as if the claim so amended was presented originally in its amended form. Thus, it is respectfully submitted that no new matter is added as the minor changes merely provide clarity without changing the scope of the claims.

Claim 1 is further amended to provide clear antecedent basis for the recited opposed direction. It is respectfully submitted that no new matter is added by way of the amendment since the amendment merely corrects a minor informality.

Claims 4-6 and 12-16 are canceled without prejudice or disclaimer.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

B. Rejection of claims 1-3, 7-11, and 17-19 under 35 U.S.C. § 112 1<sup>st</sup> paragraph

Reconsideration and withdrawal of this rejection is respectfully requested on the basis that the rejection has not met the burden required to establish a *prima facie* case of non-enablement, and further on the basis that a skilled artisan would be enabled by the disclosure to make and use the embodiments of the claims without undue experimentation.

The proper test to determine enablement is whether any person skilled in the art can make and use the invention without undue experimentation (MPEP §2164.01; *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). The initial burden is on the Patent Office to establish a reasonable basis to question the enablement provided by the specification (MPEP 2164.04; *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993)).

There are at least eight factors that must be analyzed to make a finding of non-enablement (MPEP §2164.01(a); *In re Wands*, 858 F.2d at 737 (Fed. Cir. 1988)). While it is not necessary to discuss every factor, the language of the rejection should focus on the factors, reasons, and evidence that lead the Office “to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation” (MPEP §2164.04, underlining in original). The analysis can be done “by making specific findings of fact, supported by evidence, and then drawing conclusions based on these findings of fact” (MPEP §2164.04). In a situation where the Office alleges there is missing information in the specification, the Office “should

specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation” (MPEP §2164.04).

In the pending case, the rejection states that it is in no way apparent how the slide portions 61 are arranged to slide in the first radial direction D1, and further that it is unclear how the slide portions 61 can move in the radial direction D1.

There is no analysis or findings of fact relating to any of the eight factors, for example the level of ordinary skill in the art, that are used to make a finding of undue experimentation. The rejection merely points out what is allegedly unclear, skips the evidentiary findings required to make a *prima facie* case of undue experimentation, and provides the conclusion that the claims are not enabled.

This analysis is improper and conclusory and fails to meet the burden required by the Office to establish a *prima facie* case of non-enablement.

Further, a skilled artisan would recognize from the description in the disclosure and Figures of the pending application that the slide portions 61 are able to slide along the slide surfaces 63 in the radial direction D1. As discussed in detail in the specification, there is a chance that during insertion, the axis of the positioning hole 5 and the axis of the plug member 12 may be misaligned, and may also be misaligned in the D1 direction (paragraphs [0080], [0089], [0094], and [0095]). A skilled artisan would recognize that such a misalignment in the D1 direction may result in movement of the sleeve member 15, along with the wedge member 19 in the D1 direction (paragraph [0082]). A skilled artisan would further recognize, especially in view of Fig. 3, which illustrate gaps A between the plug member 12 and the wedge member 19, that the slide portions 61 may also slide along slide surfaces 63 (in the up and down direction of Fig. 3) together with the sleeve member and the wedge member in the radial direction D1 (paragraph [0082]).

Accordingly, since the Office action has failed to establish a *prima facie* case of non-enablement, and since a skilled artisan would be enabled to make and use the embodiments of the pending claims without undue experimentation, withdrawal of this rejection is respectfully requested.

2. Rejection of claims 1-3, 7-11, and 17-19 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 6,604,738 (*Haruna*)

Reconsideration of this rejection is respectfully requested, on the basis that the *Haruna* patent fails to disclose each and every recited element of amended claim 1. The remaining claims depend from claim 1, and are therefore patentable as containing all of the recited elements of claim 1, as well as for their respective recited features.

By way of review, the embodiment of pending claim 1 requires a positioning apparatus that includes a plug member projecting from a first block and adapted for insertion into a positioning hole in a second block. A plurality of slide portions are arranged around the plug member and are opposed to each other across the plug member in an opposed direction. The slide portions are arranged for movement in a first radial direction that is substantially orthogonal to the opposed direction. A first pressing member is arranged outside the slide portions in a diametrically expandable and contractible, and an axially movable manner. A second pressing member is arranged outside the slide portions and inside the first pressing member in a diametrically expandable and contractible, and an axially movable manner. Either the first or second pressing member is arranged to be driven toward a base end by a drive arrangement such that the slide portions expand the first pressing member in a second radial direction, different from the first radial direction.

Turning to the *Haruna* patent, the inventor of the *Haruna* patent is a co-applicant of the pending application, and thus is quite familiar with the disclosure of the *Haruna* patent as well as the embodiments claimed in the pending application.

The *Haruna* patent fails to disclose every recited element of amended claim 1. In particular, the *Haruna* patent fails to disclose at least the following elements required by pending claim 1. The *Haruna* patent fails to disclose a plurality of slide portions opposed to each other across a plug in an opposed direction and arranged for movement in a first radial direction substantially perpendicular to the opposed direction, as required by amended claim 1. Further, the *Haruna* patent fails to disclose a first pressing member expanded in a second radial direction different from

the first radial direction by the slide portions, as recited in amended claim 1. Additionally, the *Haruna* patent fails to disclose the specific order of the plug, slide portions, second pressing member, and first pressing member, as recited in amended claim 1.

In particular, while the engaging members 34 of the *Haruna* patent are arranged opposed to each other in an opposed direction, and are moveable, the engaging members 34 of the *Haruna* patent move in the *same* direction as the opposed direction, and not in a radial direction *substantially orthogonal* to the opposed direction, as required by amended claim 1 (Figs. 1-4; col. 5, lines 57-65; col. 7, lines 29-49). Specifically, in referring to Fig. 1 of the *Haruna* patent, the engaging members 34 are opposed to each other in the left and right direction as shown in the Figures, and the engaging members 34 also move in the left and right direction (Figs. 1-4). The engaging members do not, however, move in a radial direction substantially orthogonal to the opposed direction (which would be into and out of the page). Thus, the *Haruna* patent fails to disclose at least a plurality of slide portions opposed to each other across a plug in an opposed direction and arranged for movement in a first radial direction substantially perpendicular to the opposed direction, as required by amended claim 1.

Additionally, the Office action refers to the shuttle 23 as a first pressing member. As can be seen in Figs 1-4 of the *Haruna* patent, the shuttle member 23 is separated from the engaging members 34 by the plug 21. Since the shuttle member 23 is separated from the engaging members 34 by the plug 21, the shuttle member 23 is not expanded by the engaging portions. Accordingly, since the shuttle member is not expanded by the engaging portions, the shuttle member is clearly not expanded in a second radial direction different from the first radial direction by the slide portions (engaging portions), as recited in amended claim 1. Thus, the *Haruna* patent fails to disclose a first pressing member expanded in a second radial direction different from the first radial direction by the slide portions, as recited in amended claim 1.

Further, the *Haruna* patent discloses plug member 21 positioned outside the engaging members 34 and inside the shuttle member 23 (Figs. 1-4). This arrangement is in clear contrast to the order of elements of plug, slide portions, second pressing member, and first pressing member, as recited in amended claim 1. Thus, the *Haruna* patent fails to disclose the specific order of the plug, slide portions, second pressing member, and first pressing member, as recited in amended claim 1.

In view of at least the above mentioned deficiencies, the *Haruna* patent fails to disclose every element recited in amended claim 1 and withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claim 1 is patentable and therefore, claims 2, 3, 7-11, and 17-19, which depend from claim 1, are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective recited features.

3. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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